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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,427	03/18/2002	Masato Watabe	220942US3 XPCT	1487

22850 7590 04/23/2004

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EXAMINER

GLESSNER, BRIAN E

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,427

Applicant(s)

WATABE MASATO ET AL.

Examiner

Brian E. Glessner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,11,13 and 14 is/are rejected.
- 7) ☒ Claim(s) 2,3 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 17 February 2004 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following office action is in response to the amendment filed on February 17, 2004. Claims 1-14 are pending in the application. Claims 5-10 have been withdrawn as being drawn to a non-elected invention. Claims 1, 4, 11, 13 and 14 are rejected. Claims 2, 3, and 12 would be allowable if rewritten in independent form to include all of the limitations of the independent claim and any intervening claims.

Drawings

The drawing correction submitted by the applicant is acceptable.

Specification

The amendment made to the abstract is acceptable.

Claim Rejections - 35 USC § 102

1. Claim 1 stands and new claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Saino (1,195,505).

In regard to claim 1, Saino discloses a door for closing an opening comprising a door panel comprising a surface board a, a back board b, and a reinforcing member c or page 2 lines 1-11, and a connecting member 16, 17 configured to connect said back board to said surface board or said reinforcing member capable of losing the force of constraint against said surface board or said reinforcing member on high temperature conditions during a fire, page 2, lines 117-130. Although Saino does not specifically disclose that said door is for closing an elevator opening, the elevator opening was not positively claimed. Therefore, since Saino's door has the same structural features of applicant's door, they will inherently be capable of functioning in the same manner.

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In regard to claim 11, Saino discloses a door for closing an opening comprising a door panel comprising a surface board a, a back board b, and a reinforcing member c or page 2 lines 1-11, and a connecting member 16, 17, 23, 24, or 26, 27 configured to connect said back board to said surface board or said reinforcing member, wherein said connecting member comprises a first connecting member 26, 27 for maintaining the fastening condition of said door panel and a second connecting member 16, 17 or 23, 24 for losing the force of constraint against said surface board or said reinforcing member on high temperature conditions during a fire, page 2, lines 117-130. Although Saino does not specifically disclose that said door is for closing an elevator opening, the elevator opening was not positively claimed. Therefore, since Saino's door has the same structural features of applicant's door, they will inherently be capable of functioning in the same manner.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 4, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saino (1,195,505).

In regard to claims 4 and 14, as now dependent from claim 1, Saino discloses the basic claimed invention, wherein said connecting member 23 is a bolt. Saino does not specifically disclose the use of a resin or rubber nut attached to the bolt. However, Saino does disclose the use of a fusible washer 24 that melts when exposed to heat to allow the bolt to pass through the

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slot. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a rubber or resin nut on the end of Saino's bolt instead of a fusible washer, since a rubber or resin nut would be functionally equivalent to the fusible washer. Both the fusible washer and the rubber or resin nut will melt when exposed to fire to allow said bolt to pass through said slot.

In regard to claim 13, Saino discloses the claimed invention, wherein said connecting member comprises a bolt 23 having a smaller head than the slot 25, and said second connecting member comprises a fusible washer 24 provided between said head of said bolt and said board a. Saino does not specifically disclose that said bolt is a rivet, that said washer is rubber or plastic, or that said washer and head are located adjacent said back board. Saino does disclose that bolts and rivets are interchangeable, page 2, lines 55-56 and 102-104. Therefore, it would have been obvious to one having ordinary skill in the art to use either a bolt or a rivet since Saino teaches that both types of fasteners are well known in the art. Further, in regard to the location of the parts, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the bolt through the panel in the reverse direction, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art.

Allowable Subject Matter

4. Claims 2, 3, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments filed February 17, 2004 have been fully considered but they are not persuasive.

In regard to the applicant's argument that Saino does not disclose a door that closes and opens an elevator opening, the examiner would like to point out that the elevator opening is not positively claimed. Therefore, Saino does not have to disclose said elevator opening. Therefore, even though the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, as stated above, the Saino reference does not have to show or teach an elevator opening.

Further, the phrase "for closing and opening an elevator opening" is functional recitation of the intended use of the door. Therefore, the examiner would like to point out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Hence, since applicant's door is not structurally different than Saino's door, it is not patentable over the Saino door.

Finally, the functional recitation "for closing and opening an elevator opening" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or

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the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone.

See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Glessner whose telephone number is 703-305-0031. The examiner can normally be reached on Monday-Friday 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B.G.
April 21, 2004

A handwritten signature in black ink, appearing to read "Brian Glessner", with a long horizontal flourish extending to the right.

BRIAN E. GLESSNER
PRIMARY EXAMINER